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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/216,440 03/23/94 ZHOU

Y 418634ACCNCH

JORDAN, K EXAMINER

12B2/0914

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805 15TH ST., N.W., STE. 700
WASHINGTON, DC 20005

ART UNIT PAPER NUMBER

1205

DATE MAILED: 09/14/94

This is a communication from the examiner in charge of your application
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-392. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 26-30 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 26-30 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 39 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☒ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☒ been filed in parent application, serial no. 07/714,229; filed on June 12, 1991
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other _____

EXAMINER'S ACTION

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Claims 26-30 are presented for examination.

Acknowledgment is made of applicant's claim for priority under 35 U.S.C. § 119. The certified copy has been filed in parent application, Serial No. 07/714,229, filed on June 12, 1991.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Claims 26-30 are rejected under 35 U.S.C. § 103 as being unpatentable over Deng (AQ) in view of Wang et al. (R).

The claims appear to be drawn to compositions and methods

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for treating malaria by orally administering synergistically effective amounts of benflumetol and artemether. Deng discloses that the combination of benflumetol and artemether has synergistic activity in the treatment of malaria (see page 375, left column, lines 3-13). The claims differ from the primary reference in claiming oral administration of the compounds and specific synergistic ratios. To administer benflumetol orally would have been obvious in view of Wang et al. which discloses the formulation of benflumetol in gelatin capsules which are known to be used as an oral dosage form. To administer artemether orally would have been obvious also, in the absence of evidence to the contrary, as oral administration is the most common form of drug administration. In this regard the declaration of Dr. Wernsdorfer stating that in 1989 artemether was known to be administered only intramuscularly has been considered. Dr. Wernsdorfer's statements only apply to what was known in the art in 1989. However, the declaration does not give any indication as to what was known in the art about the administration of artemether at the time of the applicants invention in August 1990. Thus the declaration is not persuasive as to the unobviousness of oral administration of artemether. The choice of specific synergistic ratios also would have been obvious given that Deng had already disclosed the synergistic phenomena that exists between benflumetol and artemether. Such ratios are only

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the optimization of Deng's teaching. Finally, the Zhou declaration has been considered but it does not appear to provide any evidence of unobviousness with regard to the claimed invention.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jordan whose telephone number is (703) 308-4611.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink, appearing to read "Kin J.", with a long horizontal stroke extending to the right.

Jordan:lb
September 09, 1994